



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,898	11/18/2003	Hector Fillipus Alexander Van Drentham Susman	85170-5000	7066

28765 7590 06/09/2005

WINSTON & STRAWN LLP
1700 K STREET, N.W.
WASHINGTON, DC 20006

EXAMINER

TSAY, FRANK

ART UNIT	PAPER NUMBER
----------	--------------

3672

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/716,898	SUSMAN, HECTOR FILLIPUS ALEXANDER VAN D	
	Examiner	Art Unit	
	Frank S Tsay	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 26-33 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-25, 34-37, 42, 43 and 45-50 is/are rejected.
- 7) ☒ Claim(s) 4-6, 41, 44 and 51-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of species I corresponding to claims 1-25, 34-37 and 41-63 in the reply filed on 1/21/05 is acknowledged.

Claims 26-33 and 38-40 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 21, 2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-25, 34-37, 42, 43, and 45-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Hipp '819.

Hipp discloses a well tool for generating reciprocating movements downhole, which includes a first and second members 18,10 each moveable between a respective first shown in Fig. 1, and a respective further position shown in Fig. 2 in response to an applied fluid pressure (col. 4, line 51-col. 5, line 49). The sealing assembly is met by the sealing arrangement between the tapered end 25 and the tapered seat 26 on the first and second members (col. 4, lines 17+), which prevents fluid flow therethrough in one position shown in fig. 1, and allows fluid to flow in a further position shown in Fig. 2.

Art Unit: 3672

The generally hollow housing is met by housing 1, which defines an internal bore 5 and a fluid chamber 6 for allowing fluid flow between the first and second members. The mechanical load generated by the impact of the second members is anticipated by the abstract lines 18+, and col. Col. 4, line 60-col. 5, line 28. The flow restriction adjacent an end of the first member is met by passage 24 which is slidable and received in part of the internal bore as shown in Figs 1 and 2. The downhole hammer recited in the respective claims is met by hammer 3 which generates the mechanical impact (col. Lines 25-28). The flow port defined in the wall of the first member is anticipated by Fig. 2, where a flow port is formed when the first member moves downward under increasing pumping pressure. The restraining shoulder or shoulders to abut and restrain the first member is clearly shown in Fig. 1 near reference numeral 23. The valve member adapted to receive member fails is anticipated by the valve seat 26 at the second member. The tubular shuttle valve is also anticipated by the plunger 18 which functions as a shuttle valve.

Allowable Subject Matter

Claims 4-6, 41, 44 and 51-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

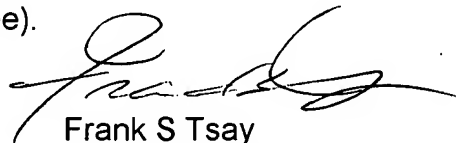
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reaugh, De Cuir, and Askew all show hydraulic jarring apparatus.

Art Unit: 3672

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank S Tsay whose telephone number is (517) 272-7038. The examiner can normally be reached on Monday thru Friday, 7:30am-5:00 pm, 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (517)272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank S Tsay
Primary Examiner
Art Unit 3672

6/2/05